

Amendment Under 37 C.F.R. §1.111
Application No. 10/551,457
Attorney Docket No. 053197

REMARKS

Claims 1, 2 and 4-7 and 9-25 are currently pending. Claims 1 and 2 are amended to include the subject matter of claim 8 and claim 8 is cancelled. Claims 19 and 20 are amended to be dependent on claims 1 and 2. Claim 21 is amended into two claims, claim 21 and new claim 25. Claim 21 is single dependent on claim 19 and new claim 25 is single dependent on claim 20.

I. The Rejections Based on WO 03/032379

Claims 1, 2, 4-15 and 19-23 are rejected under 35 U.S.C. 102(a) as allegedly being clearly anticipated by Nishiyama et al., WO 03/032379.

Claims 16-18 and 24 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Nishiyama et al., WO 03/032379 in view of Koike et al., 6,544,104.

In the "Response to Argument" section, the Examiner agrees that Nishiyama, US Patent Publication 2004/0224623 is not available as prior art. However, the Examiner makes the same rejection based on WO 03/032379, which the Examiner notes is available under 35 USC 102(a). The Examiner also notes that Applicants have not provided full translations of the foreign priority documents.

Enclosed are sworn translations of Applicants' three Japanese priority documents. Applicants therefore remove WO 03/032379 as a reference by completing their claim to priority with sworn translations of their Japanese priority applications which support the pending claims.

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The priority documents support the present claims. For example:

Claim 1 < claim 1 of JP2003-100376;
Claim 2 < claim 12, [0020], [0024] of JP2003-100376;
Claim 3 < claim 1 of JP2003-100376;
Claim 4 < claim 2 of JP2003-100376;
Claim 5 < claim 3 of JP2003-100376;
Claim 6 < claim 4 of JP2003-100376;
Claim 7 < claim 5, [0015] of JP2003-100376;
Claim 8 < claim 6 of JP2003-100376;
Claim 9 < claim 7 of JP2003-100376;
Claim 10 < claim 8 of JP2003-100376;
Claim 11 < claim 9 of JP2003-100376;
Claim 12 < claim 1 of JP2003-103477;
Claim 13 < claim 1, 5, [0009] (40-100wt%), EXAMPLE [0031] of JP2003-103477;
Claim 14 < claim 2 of JP2003-103477;
Claim 15 < claim 3 of JP2003-103477;
Claim 16 < claim 1 of JP2003-103624;
Claim 17 < claim 2 of JP2003-103624;
Claim 18 < claim 3 of JP2003-103624;
Claim 19 < claims 10 and 11 of JP2003-100376 and claim 4 of JP2003-103477;
Claim 20 < claim 5, [0017] of JP2003-103477;
Claim 21 < claim 12 of JP2003-100376;
Claim 22 < claim 13 of JP2003-100376, claim 6 of JP2003-103477, claim 5 of JP2003-103624;
Claim 23 < claim 16 of JP2003-100376; and
Claim 24 < claim 4 of JP2003-103624.

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In view of the above, Applicants submit that Nishiyama et al., WO 03/032379 is not available as prior art and requests that the rejections under 35 U.S.C. §§102 and 103 be withdrawn.

II. The Rejection Based on Tolles in view of Jensen, Jr.

Claims 1, 2, 7, 9, 10, 11, 19, 20, 22 and 23 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Tolles 6,533,645 in view of Jensen, Jr. 4,728,552.

Claim 8 has not been rejected based on Tolles in view of Jensen, Jr. Applicants have amended independent claim 1 to recite the subject matter of claim 8. Further, all of the other claims depend from claim 1.

The present application is an improved polishing pad with (1) a reduced content of fiber and (2) a thermoplastic resin as binder as claimed. The present application provides a polishing pad that is capable of detection of polishing end point by light transmission and of producing by extrusion or injection molding with maintenance of the polishing property such as polishing speed, reduction of scratch and corrosion.

Tolles and Jensen Jr., as well as WO 03/032379, have no description or reason to use the above constituent features (1) and (2) and do not have any teachings that the claimed invention can provide a polishing pad which is capable of detection of polishing end point by light transmission and of producing by molding with maintenance of the polishing property.

For the above reasons, it is respectfully submitted that the subject matter of claims 1, 2 and 4-7 and 9-25 is neither taught by nor made obvious from the disclosures of Tolles and Jensen, Jr. and it is requested that the rejection under 35 U.S.C. §103(a) be reconsidered and withdrawn.

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III. Conclusion

In view of the above, Applicants respectfully submit that their claimed invention is allowable and ask that the rejection under 35 U.S.C. §102 and the rejections under 35 U.S.C. §103 be reconsidered and withdrawn. Applicants respectfully submit that this case is in condition for allowance and allowance is respectfully solicited.

If any points remain at issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the local exchange number listed below.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,
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